

**REMARKS**

Claims 16-38 are pending in this application after this Amendment. Claims 1-15 have been canceled without prejudice or disclaimer to the subject matter contained therein. Claims 16, 22, 29-31, and 38 are independent. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1, 7, and 14-15 under 35 U.S.C. § 112, second paragraph. The Examiner further asserted a Requirement for Information under 37 C.F.R. § 1.105. Finally, the Examiner further rejected claims 1-10 and 13-15 under 35 U.S.C. § 102(e) as being anticipated by *Barnett et al.* (USP 6,336,099); and rejected claims 11-12 under 35 U.S.C. § 103(a) as being unpatentable over *Barnett et al.* Applicants respectfully traverse these rejections.

By this Amendment, Applicants have canceled claims 1-15 and present new claims 16-38 for consideration by the Examiner. These new claims are being presented to more appropriately recite the present invention.

**Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 1 and 7, asserting the phrase "can operate" renders the claims indefinite. The Examiner further rejected claims 14 and 15, asserting the word "allowing" renders the claims indefinite. By this Amendment, Applicants have canceled

these claims and provided new claims which more appropriately recite the present invention. As such, it is respectfully requested that the outstanding rejection be withdrawn.

**Requirement for Information Under 37 C.F.R. § 1.105**

In the outstanding Official Action, the Examiner asserts a Requirement for Information under 37 C.F.R. § 1.105. Specifically, the Examiner requires the Applicants provide full translations of Japanese patents JP 11-338809 and JP 9-163352, which were listed in an Information Disclosure Statement submitted by the Applicants. The Examiner asserts the abstracts were of relevance to the instant application and therefore requires full translations of the patents. Applicants respectfully submit that this Requirement for Information is improper under 37 C.F.R. § 1.105.

A Requirement for Information may be improper where the information is equally available to the Examiner. *Star Fruits S.N.C. v. United States*, 73 USPQ 2d 1409, CAFC 2005.

Applicants respectfully submit that the translations of Japanese patents are equally available at the Japanese Patent Office web site to both the Examiner and the Applicants. As such, Applicants maintain that this Requirement is not proper under 37 C.F.R. § 1.105.

However, Applicants are properly responding to the Examiner's Requirement for Information by enclosing herewith full translations of Japanese patents JP 11-338809 and JP 9-163352. Based upon these

submissions, Applicants have satisfied the Examiner's Requirement for Information.

**Claim Rejections - 35 U.S.C. § 102**

The Examiner rejected claims 1-10 and 13-15 under 35 U.S.C. §102(e) as being anticipated by *Barnett et al.* With regard to claim 1, the Examiner asserts that *Barnett et al.* teaches advertisement using means. However, the Examiner fails to provide any citation to the *Barnett et al.* reference in support of her assertions. Further, the Examiner asserts that *Barnett et al.* teaches advertisement use information sending means, asserting *Barnett et al.* teaches sending user data to the coupon distributor 16. Applicants respectfully disagree with the Examiner's characterization of this reference.

The disclosure of *Barnett et al.* is directed to a method and system for electronic distribution of product redemption coupons. The system disclosed in *Barnett et al.* includes personal computer 6 and communicates with a network through online service provider 2. The online service provider 2 communicates with personal computer 6 in order to transmit requested coupon data, and also in order to receive coupon requests and user-specific data (col. 7, lines 2-5). Coupons 18 include user-specific data in the form of unique user bar code 90. The user bar code 90 is encoded with user-specific information such as the user name and/or other unique identification criteria such as a social security number of online service address (col. 7, lines 22-30).

Coupon redemption center 13 receives from a number of stores 10 the coupons redeemed, verifies the value of the redeemed coupons, determines the identification of users who redeemed the coupons, and distributes the information read from the coupons 18 to the individual coupon issuer 14 and the coupon distributor 16 (col. 7, lines 36-41).

In contrast, the present invention as set forth in claim 16 recites, *inter alia*, an information communication system including an information terminal device and an information collecting device capable of exchanging information therebetween via communication channel, wherein **the information terminal device comprising** advertisement using module for detecting a user operation by a user interface occurring upon display of an advertisement or any other user operation during the display of the advertisement, instructing a service based on the displayed advertisement and outputting advertisement use information indicating a use situation of the displayed advertisement; and advertisement use information transmitter which is connected to the communication channel and sends the stored advertisement use information to the information collecting device via the communication channel.

As noted above, the *Barnett et al.* system provides for collecting advertisement use information at coupon redemption center 13 and distributing this information to coupon issuer 14 and coupon distributor 16. There is no teaching or suggestion in

*Barnett et al.* that is directed to an advertising using module at the information terminal device. Further, there is no advertisement use information transmitter taught by *Barnett et al.* at the information terminal device. As such, *Barnett et al.* fails to anticipate the present invention. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 17-21 are allowable for the reasons set forth above with regard to claim 16 at least based upon their dependency on claim 16. It is further respectfully submitted that claims 22, 29, 31, and 38 include elements similar to those discussed above with regard to claim 16 and, thus, these claims, together with claims dependent thereon, are not anticipated by *Barnett et al.*

Further, as *Barnett et al.* fails to teach or suggest all of the elements as set forth in claim 30, it is respectfully requested that new claim 30 is not anticipated by *Barnett et al.*

#### **Claim Rejections - 35 U.S.C. § 103**

The Examiner rejects claims 11-12 under 35 U.S.C. § 103(a) as being unpatentable over *Barnett et al.* Applicants respectfully traverse this rejection.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be

some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In support of the Examiner's rejection of claim 11, the Examiner asserts it makes sense to perform the recited claim elements in order to not discontinue the presentation of the information and to not further damage the system and delay the turning on of the power until service is rendered. The Examiner then concludes it would be obvious to a person of ordinary skill in the art at the time of the Applicants' invention to have included presenting the advertisements when the power is turned off and suspending the turning off of the power to instruct the service in order to achieve the above-mentioned advantage. However, the Examiner fails to provide any reference that teaches or suggests this claim element. As noted above, in order to assert a proper *prima facie* obviousness rejection under 35 U.S.C. § 103, the Examiner must provide references that teach or suggest all of the claim elements. As the Examiner has failed to provide such a reference that teaches the claimed element, it is respectfully requested that the outstanding rejection be withdrawn.

With regard to the Examiner's rejection of claim 12, the Examiner takes Official Notice that it is old and well known to suspend an operation when a warning is displayed in order to avoid systems problems. Applicants respectfully traverse this Official Notice and request that the Examiner provide a properly combinable prior art reference that cures the deficiencies of the teachings of *Barnett et al.*

#### Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition for a two (2) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$450.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Machine translations of JP 9-163352 and JP 11-338809